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09/123,109	07/27/1998	JAMES DUKE BOND	RIC-97-120	5163

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MCI, INC  
TECHNOLOGY LAW DEPARTMENT  
1133 19TH STREET NW, 10TH FLOOR  
WASHINGTON, DC 20036

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 05/07/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/123,109

**Applicant(s)**

BOND ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1-4, 6-12, 14-15, 19-22, 24-28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu et al. (US 5,787,151) in view of Taskett (US 5,923,734).

Regarding **claim 1**, Nakatsu discloses a telephony based delivery system of messages containing selected greeting (column 1, lines 12-15), (which reads on claimed "a system for recording a personal greeting associated with a card"), comprising:

a data storage system (28 on FIG. 1) for storing data (column 4, line 13 "their related information") corresponding to a card (column 4, line 7 "voice card messages") and a personal greeting (column 4, line 11 "previously captured messages") related to the card (column 4, lines 7-19) [The storage node is provided for mass storage of the captured voice card messages and their related information]; and

a card processing system (12 on FIG. 1) coupled to the data storage system and configured to receive request to record (column 9, line 28 "to receive a voice command to the IVR process") the personal greeting during a card setup call (column 9, line 23 "the capture/query call flow") over a telephone network (10 on FIG. 1) and cause the personal greeting to be recorded during the card setup call (column 9, lines 22-41) [The IVR system prompts the caller to record a personal greeting at the voice card while setting up the call messages for the recipient of the voice card messages].

Nakatsu discloses a telephony base electronic greeting card but fails to disclose the voice card as a pre-paid telephone calling card.

However, Taskett teaches a pre-paid telephone calling card with special greetings to the caller (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the pre-paid telephone calling card with special greeting of Taskett in the voice card system and allow the receiver to call to retrieve the personal greeting left by the caller of Nakatsu.

The modification of the invention would offer the capability of the pre-paid telephone calling card with special greeting such as the system would permit an issuer to market his cards for providing access to the service database.

Regarding **claims 2 and 20**, Taskett teaches the data storage system and the pre-paid calling card processing system are remotely located (column 5, lines 15-29) [The user dials a number to access the service provider therefore they are remotely located].

Regarding **claims 3, 11, 21 and 28**, Taskett teaches the data corresponding to the pre-paid telephone calling card includes a quantity corresponding to a number of service units available to be used to make at least one call in relation to the pre-paid telephone calling card (column 5, lines 30-45) [The user is prompted for additional information such as authorization code and the desired long distance phone number].

Regarding **claims 4, 12 and 22**, Taskett teaches the call is a long distance telephone call (column 6, lines 1-3).

Regarding **claims 6, 14 and 24**, Taskett teaches the pre-paid telephone calling card processing system causes the personal greeting to be recorded within the data storage system in accordance with a card identifier corresponding to the pre-paid telephone calling card (column 6, lines 47-58) [The account database stores prepaid accounts and voice library storing prerecorded voice messages].

Regarding **claims 7 and 25**, Taskett teaches a voice data storage facility coupled to the pre-paid telephone calling card processing system and to the data storage system, and operative to store the personal greeting based on a card identifier corresponding to the pre-paid telephone calling card (column 7, lines 13-32) [Based upon the dialed phone number the system determines the image and the personal greeting associated with the prepaid telephone card].

Regarding **claims 8 and 26**, Nakatsu discloses a voice response system coupled to the card processing system and configured to prompt a caller to record the personal greeting via at least one voice prompt during the setup call over the telephone network (column 12, lines 45-52) but fails to disclose the prepaid pre-paid telephone calling processing system.

However, Taskett teaches a pre-paid telephone calling card processing system (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card].

Regarding **claim 9**, Nakatsu discloses the personal greeting is to be played back via the card processing system during an access call related to the card (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card and prompts the user for instruction to make the outgoing call] but fails to disclose the access call made in accordance with the use of the pre-paid telephone calling card.

However, Taskett teaches the access call made in accordance with the use of the pre-paid telephone calling card (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card].

Regarding **claim 10**, Nakatsu discloses a telephony based delivery system of messages containing selected greeting (column 1, lines 12-15), (which reads on claimed "a method for recording a personal greeting"), comprising the steps of:

storing data (column 4, line 13 "their related information") corresponding to a card (column 4, line 7 "voice card messages") and a personal greeting (column 4, line 11 "previously captured messages") to be associated with the card (column 4, lines 7-19) [The storage node is provided for mass storage of the captured voice card messages and their related information];

receiving a request to record (column 9, line 28 "to receive a voice command to the IVR process") the personal greeting during a card setup call (column 9, line 23 "the capture/query call flow") over a telephone network (column 9, lines 22-41) [The IVR

system prompts the caller to record a personal greeting at the voice card while setting up the call messages for the recipient of the voice card messages]; and

causing the personal greeting to be recorded during the card setup call (column 10, lines 24-36) [The IVR system prompts the caller to record a personal greeting at the voice card while setting up the call messages for the recipient of the voice card messages], the personal greeting to be play back during an access call (column 13, line 17 "the delivery call") related to the use of the card (column 13, lines 33-40) [The voice card system at the delivery call play out of the voice card messages to the recipient based on the response of the intended recipient].

Nakatsu discloses a telephony base electronic greeting card but fails to disclose the voice card as a pre-paid telephone calling card.

However, Taskett teaches a pre-paid telephone calling card with special greetings to the caller (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the pre-paid telephone calling card with special greeting of Taskett in the voice card system and allow the receiver to call to retrieve the personal greeting left by the caller of Nakatsu.

The modification of the invention would offer the capability of the pre-paid telephone calling card with special greeting such as the system would permit an issuer to market his cards for providing access to the service database.



Regarding **claims 15 and 30**, Taskett teaches the personal greeting stored during the causing step is to be played back automatically during an access call related to the pre-paid telephone calling card (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card].

Regarding **claim 19**, Nakatsu discloses a telephony based delivery system of messages containing selected greeting (column 1, lines 12-15), (which reads on claimed "a system for facilitating the use of a card having an associated pre-recorded personal greeting"), comprising:

a data storage system (28 on FIG. 1) for storing data (column 4, line 13 "their related information") corresponding to a card (column 4, line 7 "voice card messages") and to a personal greeting (column 4, line 11 "previously captured messages") related to the card (column 4, lines 7-19) [The storage node is provided for mass storage of the captured voice card messages and their related information]; and

a card processing system (12 on FIG. 1) coupled to the data storage system and to cause the personal greeting to be played during the access call (column 13, lines 33-40) [The voice card system at the delivery call play out of the voice card messages to the recipient based on the response of the intended recipient].

Nakatsu discloses a voice card processing system but fails to disclose a prepaid telephone calling card processing system configured to receive a request to make an outbound telephone call during an access call over.

However, Taskett teaches a prepaid telephone calling card processing system (308 on FIG. 3) configured to receive a request to make an outbound telephone call (column 5, line 40 "the desired long distance phone number") during an access call over (column 5, line 33 "Upon dialing access phone number") a telephone network (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card and prompts the user for instruction to make the outgoing call].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the pre-paid telephone calling card with system of Taskett in the voice card system and allow the receiver to call to retrieve the personal greeting left by the caller of Nakatsu.

The modification of the invention would offer the capability of the pre-paid telephone calling card with special greeting such as the system would permit an issuer to market his cards for providing access to the service database.

Regarding **claim 27**, Nakatsu discloses a telephony based delivery system of messages containing selected greeting (column 1, lines 12-15), (which reads on claimed "a method for facilitating the use of a card having an associated pre-recorded personal greeting"), comprising:

storing data (column 4, line 13 "their related information") corresponding to a card (column 4, line 7 "voice card messages") and to a personal greeting (column 4, line 11 "previously captured messages") related to the card (column 4, lines 7-19) [The storage

node is provided for mass storage of the captured voice card messages and their related information];

causing the personal greeting to be played during the access call (column 13, lines 33-40) [The voice card system at the delivery call play out of the voice card messages to the recipient based on the response of the intended recipient], wherein the personal greeting was recorded during a card setup call (column 9, lines 22-41) [The IVR system prompts the caller to record a personal greeting at the voice card while setting up the call messages for the recipient of the voice card messages].

Nakatsu discloses receiving a call for recording messages on a telephone based card processing system but fails to disclose receiving a request to make an outbound telephone call in relation to the pre-paid telephone calling card during an access call over a telephone network.

However, Taskett teaches receiving a request to make an outbound telephone call (column 5, line 40 "the desired long distance phone number") in relation to the pre-paid telephone calling card during an access call (column 5, line 33 "Upon dialing access phone number") over a telephone network (column 5, lines 30-45) [The card user upon accessing the service provider network a greeting is played back to the user of the telephone calling card based upon the photograph on the calling card and prompts the user for instruction to make the outgoing call].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the pre-paid telephone calling card with system of Taskett in

the voice card system and allow the receiver to call to retrieve the personal greeting left by the caller of Nakatsu.

The modification of the invention would offer the capability of the pre-paid telephone calling card with special greeting such as the system would permit an issuer to market his cards for providing access to the service database.

5. **Claims 5, 13, 23 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho in view of Bruno and in further view of Nguyen et al. (US 5,815,561).

Regarding **claims 5, 13, 23 and 29**, Nakatsu and Taskett as applied to **claims 3, 12, 21 and 28** differ from **claims 5, 13, 23 and 29** in that it fails to disclose the service units correspond to telephone call service minutes.

However Nguyen teaches a system, wherein the service units correspond to telephone call service minutes (column 13, lines 30-36) [The system is cost limited services for duration of a communication, beeps warning the user for the minutes used].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the service units correspond to telephone call service minutes of Nguyen in the invention of Nakatsu and Taskett.

The modification of the invention would offer the capability of the service units correspond to telephone call service minutes such as the system would implementing duration demarcated for cost limited communication services.

6. **Claims 16 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Nakatsu.

Regarding **claim 16**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17 and column 3, line 55 “prepaid calling cards”), (which reads on claimed “a method of using a pre-paid telephone calling card”) comprising the steps of:

accessing a pre-paid telephone calling card processing system (column 7, line 15 “service provider”) during a pre-paid telephone calling card setup call (column 7, lines 13-14 “dialing access number”) via a telephone network (column 7, lines 13-32) [Depending of the image on the phone the user will dial an access number then the system will present the user a menu];

entering a card identifier (column 7, lines 38-39 “access code”) corresponding to data addressable by the pre-paid telephone calling card system (column 7, lines 33-39) [Additional information is requested from the user to access the system].

Taskett discloses a prepaid telephone card system containing audio indicia related to the visual image on the prepaid telephony card but fails to disclose recording a personal greeting during the setup call, the personal greeting being addressable by the telephone processing system during a subsequent telephone service access call.

However, Nakatsu teaches recording a personal greeting during the setup call (column 9, lines 22-41) [The IVR system prompts the caller to record a personal greeting at the voice card while setting up the call messages for the recipient of the

voice card messages], the personal greeting being addressable by the telephone processing system during a subsequent telephone service access call (column 13, lines 33-40) [The voice card system at the delivery call play out of the voice card messages to the recipient based on the response of the intended recipient].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the recording of a personal greeting during a subsequent telephone service access call of Nakatsu in the invention of Taskett.

The modification of the invention would offer the capability of recording a personal greeting during a subsequent telephone service access call such as the user may record a personal greeting for delivering the message over a telephone network.

Regarding **claim 17**, Taskett teaches the personal greeting is stored in a data storage system in accordance with the card identifier (column 8, lines 20-29).

Regarding **claim 18**, Nakatsu teaches the telephone network is the publicly switched telephone network (column 8, lines 1-18).

Regarding **claim 31**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17 and column 3, line 55 "prepaid calling cards"), (which reads on claimed "a method of using a pre-paid telephone calling card") comprising the steps of:

accessing a prepaid telephone calling card processing system (column 7, line 15 "service provider") during a telephone service access call (column 7, line 13 "upon dialing access number") via a telephone network (column 7, lines 13-32) [Depending of the image on the phone the user will dial an access number then the system will present the user a menu];

entering a card identifier (column 7, line 38 "access code") corresponding to data addressable (column 7, line 35 "additional information") by the pre-paid telephone calling card processing system (column 7, lines 33-39) [The system prompts the user to enter an access code over the telephone line];

retrieving a pre-recorded greeting (column 7, line 35 "voice recordings") associated with the pre-paid telephone calling card based on the card identifier entered during the entering step (column 7, lines 33-39) [The system retrieves the appropriate portion of audio indicia based upon the image on the telephone card].

playing the pre-recording personal greeting during the telephone access service access call (column 7, lines 33-39) [The system relays to the user the voice recording from the audio library during the telephone call]

Taskett discloses personal greeting from various celebrities upon accessing the service provider but fails to disclose the personal greeting was recorded during a calling card setup.

However, Nakatsu teaches wherein the personal greeting was recorded during a card setup (column 9, lines 22-41) [The IVR system prompts the caller to record a

personal greeting at the voice card while setting up the call messages for the recipient of the voice card messages].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the personal greeting that was recorded during a card setup during a subsequent telephone service access call of Nakatsu in the invention of Taskett.

The modification of the invention would offer the capability of the personal greeting that was recorded during a card setup during a subsequent telephone service access call such as the user may record a personal greeting for delivering the message over a telephone network.

Regarding **claim 32**, Taskett teaches the step of entering a terminating telephone number to which an outbound call will be placed automatically after the pre-recorded personal greeting has been played (column 5, lines 30-45).

Regarding **claim 33**, Taskett teaches the accessing and entering steps are carried out remotely from the retrieving and playing steps (column 7, lines 13-39).

### ***Response to Arguments***

7. Applicant's arguments with respect to **claims 1-33** have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Small is cited for a method for electronically dispensing personalized greeting cards (FIG. 1).

Wright et al. is cited for an electronic greeting card store and communication system (FIG. 1).

Barber et al. is cited for a telecommunications network-based greeting card method (FIG. 1).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



g.g.

April 25, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

